

II. REPLY TO REJECTION ON GROUND OF DEFECTIVE REISSUE DECLARATION.

Claims 25-39 have been rejected as being based upon a defective reissue declaration under 35 U.S.C. §251 and 37 C.F.R. §1.175(a)(2) and (3).

In response, Applicant would point out that it appears that the Office Action is based on a version of 37 C.F.R. §1.175 no longer in effect.

As of October 10, 1997, 37 C.F.R. §1.175 was amended to reduce the onerous requirements upon which the rejection has been made. 62 F.R. 53132, October 10, 1997. Furthermore, it is noted that the reissue application declaration by the inventor filed in this application uses form PTO/SB/51 (12-97), the Patent Office form currently believed to be in effect, and the form which sets forth the appropriate reissue application declaration by the inventor.

For the above reasons, it is respectfully requested that this rejection be withdrawn.

III. REPLY TO REJECTION OF CLAIMS 25-29 UNDER 35 U.S.C. §251 AS BEING AN IMPROPER RECAPTURE OF BROADENED CLAIM SUBJECT MATTER SURRENDERED IN THE PARENT APPLICATION

Claims 25-29 have been rejected under 35 U.S.C. §251 as being an improper recapture of broadened claim subject matter surrendered in the parent application for the patent upon which the present reissue is based. The Office Action cited *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); and *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

Allegedly, the reissue claims have a narrower scope as related to the use of a pen or in clothing, but are otherwise broader with respect to using isotopic taggant or defining the species of the isotopic ratios that were argued in the rejection of the initial claims in the parent application.

A. No Surrender By Claim Amendment.

While Applicant acknowledges that the recapture estoppel rule prevents the patentee from regaining through reissue subject matter surrendered in an effort to obtain allowance of original claims, no such surrender took place here. The specific rule in *In re Clement, supra*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997), in the words of the Federal Circuit is that claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. As expressed by the Federal Circuit in *Clement*, the recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." *Id.* 131 F.3d at 1468, 45 USPQ 2d at 1164. However, in the present reissue application, no inventive subject matter was surrendered, much less the subject matter alleged in the Office Action.

With reference to the independent claims added by the present reissue application, it may be seen that these claims do not represent a broadening of subject matter surrendered in the original application, but rather represent entirely new subject matter which had not been claimed in the parent application. Thus, independent claim 25 is directed to a taggant pen and not to a taggant composition as set forth in the original patent. Similarly, independent claim 29 is directed to a

method of securing the authenticity of a document by marking the document with a pen. No such method is claimed in the original patent.

With respect to the amendments made to claims 1 and 4 of that application, it is readily apparent that those amendments were made to correct a grammatical error and clarify, but not change the scope of any of the claims. For example, the word "isotopic" was used to modify "abundance ratio"; however, it is readily apparent that the term "isotopic" was implied from the context of the original claim. Similarly, the amended language "wherein said abundance ratio being unchanged by chemical reactions" was not necessary to render the claims patentable over the cited references. This language did not change the scope of the claims. An isotopic abundance ratio of two stable isotopes of the same element will not be modified by non-nuclear physical or chemical processes except those specifically designed for isotopic separation so that the taggant code will not be destroyed by chemical reaction. The original claims required the isotopes to be "stable isotopes", which inherently will not be destroyed by chemical reaction.

B. No Surrender By Attorney Argument.

Applicant also acknowledges that *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) stands for the proposition that the recapture estoppel rule can be triggered by attorney argument alone. In that case the reissue applicant had not amended his claim in any relevant respect during prosecution of the application that matured into the original patent; however, his attorney had repeatedly and emphatically emphasized two limitations that were present

in the claims as originally filed. In *Hester*, the Federal Circuit broadened the rule to apply to attorney argument alone, and expressly acknowledged that in both *Clement, supra*, and *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984) that the recapture estoppel rule applies only to attempts to recapture subject matter given up through amendment of claims during prosecution of the application for the patent upon which the reissue is based.

During prosecution of the parent application, it is readily apparent that the claims were allowed on the basis of attorney argument rather than claim amendments. Also, the attorney arguments advanced in the parent case were not directed to the presently claimed subject matter, i.e., a taggant pen or a method of securing the authenticity of a document by marking the document with a pen. See, for example, the arguments in the section entitled "Amendment", received in "Group 250" on February 6, 1998, at pages 7-20, and which demonstrates the patentability of the subject matter in the original claims.

For all of the above reasons, it is submitted that no amendment in the original application surrendered inventive subject matter, and thus there is no basis for recapture estoppel to apply in the present reissue application under *Clement, supra*, and *Ball Corp, supra*. Similarly, there was no repeated and emphatic emphasis on limitations present in the claims as originally filed sufficient to give rise to a recapture estoppel under the rule in *Hester Industries, supra*. For all of the above reasons, it is respectfully requested that the rejection based on the recapture estoppel rule be withdrawn.

IV. ACKNOWLEDGMENT OF ALLOWANCE OF CLAIMS 1-24.

The allowance of claims 1-24 in the Office Action is acknowledged.

V. CONCLUSION

For all of the above reasons, it is believed that the application is now in condition for allowance, and such action is respectfully requested.

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Respectfully submitted,



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